

### III. REMARKS

Reconsideration of the present application is respectfully requested.

Reconsideration of this application in view of the following remarks is respectfully requested. Claims 1, 3, 8-10, 12-27, 29-32, and 35-45 are currently pending.

#### A. Double Patenting Rejection

Claims 1, 3, 8-10, 12-27, 29-32, and 35-45 were rejected under 35 U.S.C. 101 “as claiming the same invention as that of claims 1-55 of prior U.S. Patent No. 6,375,957, Kaiko et al.”

In response, the Examiner is reminded that “[a] good test, and probably the only objective test, for “same invention” is whether one of the claims could be literally infringed without literally infringing the other.” *In re Vogel*, 164 USPQ 619, 622 (CCPA 1970). If it could be, the claims do not define identically the same invention.” *Id.*

Claim 1 of the present application is recites “. . . a combination product which is analgesically effective when the combination is administered orally, but which (i) is aversive in physically dependent human subjects when administered in the same amount **and** in a higher amount than said therapeutically effective amount . . . .” (emphasis added).

Claim 41 of the present application recites “. . . a combination product which is analgesically effective when the combination is administered orally, but which (i) is aversive in physically dependent human subjects when administered **in the same amount** as said therapeutically effective amount . . . .” (emphasis added).

In contrast, independent claim 1 of U.S. Patent No. 6,375,957 recites “. . . . a combination product which is analgesically effective when the combination is administered orally, but which (i) is aversive in physically dependent human subjects when administered in

the same amount or in a higher amount than said therapeutically effective amount . . . .”  
(emphasis added).

Further, this limitation recited in claim 1 of U.S. Patent No. 6,375,957, is also recited in independent claims 32, 54, and 55 of U.S. Patent No. 6,375,957.

As claim 1, 32, 43, and 55 of U.S. Patent No. 6,375,957 could be infringed by a combination product which is aversive in physically dependent human subjects when administered in a higher amount than said therapeutically effective amount (without being aversive in physically dependent human subjects when administered in the same amount as said therapeutically effective amount), it is respectfully submitted that the claims of U.S. Patent No. 6,375,957 could be literally infringed without literally infringing the claims of the present application.

In view of the above remarks, the Examiner is respectfully requested to withdraw the double patenting rejection under 35 U.S.C. 101.

**IV. Conclusion**

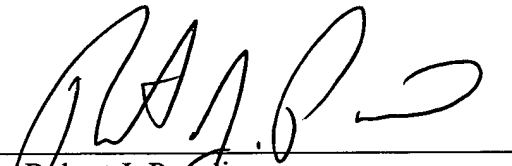
It is now believed that the above-referenced rejection has been obviated and it is respectfully requested that the rejection. It is believed that all claims are now in condition for allowance.

According to currently recommended Patent Office policy the Examiner is specifically authorized to contact the undersigned in the event that a telephonic interview will advance the prosecution of this application.

An early and favorable action is earnestly solicited.

Respectfully submitted,  
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